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| 09/439,264 | 11/12/1999 | KUNIHIKO MIWA | JA9-98-171 | 1450 |

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| EXAMINER | |
|---|---|
| PYZOCHA, MICHAEL J | |
| ART UNIT | PAPER NUMBER |
| 2137 | |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/439,264 | MIWA ET AL. | |
| | Examiner | Art Unit | |
| | MICHAEL PYZOCHA | 2137 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *10 July 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *35-41* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *35-41* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

## DETAILED ACTION

1. Claims 35-41 are pending.

2. Amendment filed 07/10/2008 has been received and considered.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 35-41 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 35, 38 and 40 require that the detecting does not include the detection of the presence or absence of a copy mark. Claim 37 requires that the adding is not dependent upon the type of media the digital data has been written. Both of these negative limitations lack support in the specification. The mere absence of a positive recitation is not basis for an exclusion as such these claims fail to comply with the written description requirement. See MPEP 2173.05(i).

Any claims not specifically addressed are rejected by virtue of their dependencies.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 35-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Admitted Prior Art (herein after AAPA) in view of Linnartz (US 6209092).

As per claims 35 and 38, AAPA discloses a method or recording digital data onto a medium using a copy mark and additional information, said method being executed by a video driver card, comprising the steps of: detecting from digital data and additional information that may be electronically embedded in said digital data, said additional information being 2-bit digital data, said detecting not including the detection of the presence or absence of a copy mark (see specification page 2 lines 14-33); If said additional information is detected performing access control for said digital data using said additional information, said access control being either to stop copying of said digital data or allow copying of said digital data to proceed, and for all combinations of said 2-bit digital data pursuant to which copying of said digital data is allowed to proceed, not making any assessment of whether a copy mark is also present in said digital data and embedding a copy mark into said digital data (see specification page 2 lines 22-27); recording the digital data, additional information, and copy mark onto a writable medium so as to control subsequent copying or playback of said digital data

recorded on said writable medium by way of said additional information (see specification page 2 lines 22-34).

AAPA fails to explicitly disclose the well-known concept of scrambling the content recorded on the writable medium.

However, Linnartz teaches scrambling of data recorded on a writable medium (see column 11 lines 53-56).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to scramble the digital data of AAPA.

Motivation to do so would have been to include additional protection for the data (see Linnartz column 11 lines 53-56).

As per claims 36 and 39, the modified AAPA and Linnartz system discloses the copy mark indicates whether copying/recording of said digital data is to be stopped continued after the addition of the copy mark (see AAPA page 2 lines 22-34).

As per claims 37 and 40, the modified AAPA and Linnartz system discloses a method of performing playback control of digital data that is both scrambled and embedded with additional information, said method being executed by a video driver card, comprising the steps of: reading said scrambled digital data from said medium; descrambling said digital data to detect said additional information embedded in descrambled digital data, said additional information being 2-bit digital data (see AAPA page 2 lines 14-20 and 35-46 and Linnartz column 11 lines 53-56); determining the contents of said detected 2-bit digital data; if said contents of the 2-bit data has a particular value and a copy mark is not present, adding a copy mark to the digital data

wherein the adding of a copy mark is not dependent upon a determination of the type of media on which the digital data has been written; and controlling playback of said descrambled digital data using said copy mark (see AAPA page 2 lines 14-46 and Linnartz column 11 lines 53-56).

As per claim 41, the modified AAPA and Linnartz system discloses the copy mark indicates whether copying/recording of said digital data is to be stopped continued after the addition of the copy mark (see AAPA page 2 lines 22-34).

### *Response to Arguments*

7. Applicant's arguments filed 07/10/2008 have been fully considered but they are not persuasive. Applicant argues that the combination of AAPA and Linnartz requires the detecting of a copy mark; and requires the knowledge of the type of media.

With respect to Applicant's argument that the combination of AAPA and Linnartz requires the detecting of a copy mark, one of ordinary skill in the art would recognize that the three different 2-bit values do not require detecting a copy mark. As shown on page two of Applicant's specification, lines 26-27 and lines 30-33 either stop or allowing recording based on 2-bit information without a copy mark. While, the first 2-bit value (1,0) does require an absence of a copy mark, one of ordinary skill in the art would recognize that a substitution of performing the step of adding a CM when the 2-bit information is (1,0) would result in the predictable result of only stopping recording when the 2-bit information is (1,1). Therefore, the combination does not require the detecting of a copy mark.

With respect to Applicant's argument that the combination of AAPA and Linnartz requires the knowledge of the type of media, Linnartz teaches that a playback device checks the copy protection information for all media and determines whether to allow or stop playback based on this information (see FIG. 1 and corresponding description in columns 7 and 8). When combined with AAPA this would negate the requirement to know the type of media. Therefore, the combination does not require knowledge of the type of media.

## *Conclusion*

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ezaki et al. and Kori teach the use of 2-bit copy protection information without the use of a copy mark or knowledge of the media type.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL PYZOCHA whose telephone number is (571)272-3875. The examiner can normally be reached on Monday-Thursday, 7:00am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. P./
Examiner, Art Unit 2137

/Emmanuel L. Moise/
Supervisory Patent Examiner, Art Unit 2137